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09/871,569	05/31/2001	Robert J. Feilbogen	10251-027	3485

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Proskauer Rose LLP
Patent Department
1585 Broadway
New York, NY 10036

EXAMINER

BORLINGHAUS, JASON M

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,569

Applicant(s)

FEILBOGEN ET AL.

Examiner

Jason M. Borlinghaus

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/17/01 & 2/14/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

In view of applicant's argument contained within the response filed 1/03/2006, examiner withdraws election/restriction requirement. Claims will be examined in their entirety as originally filed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

To ensure clarity and clear understanding of examiner's rationale for application of cited prior art, references terminology contained within parentheses indicates quoted language contained within or general concepts conveyed by said cited prior art

references. Such parenthetical terminology is to be interpreted as “reading on” or being “mapped to” the claim language prior to such parenthetical inclusions.

Claims 1 – 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US Patent 6,460,020) in view of Mancini (US Patent 7,024,383).

Regarding Claim 1, Pool discloses a method for monitoring business transactions to provide foreign currency exchange hedging instructions and to provide foreign currency price information for goods of commerce, comprising the steps of:

- receiving proposed business transaction information (“particular product is selected in the customer’s currency”) regarding at least one of purchases and sales of goods by a customer. (see col. 5, lines 10 – 23 and col. 5, line 58 – col. 6, line 3);
- receiving hedging rules (currency conversion programming), wherein said hedging rules define rules to exchange a first type of currency (“currency of country in which the catalogue originates”) to a second type of currency (“[currency] selected by the customer”). (see col. 5, line 59 – col. 6, line 3);
- receiving pricing rules (currency conversion timing and display programming), wherein said pricing rules define rules to update public foreign currency prices of said goods. (see col. 6, lines 4 – 50);
- generating public price information to provide foreign currency prices of said goods (“the price is displayed to the customer”), based on said pricing rules. (see col. 6, lines 4 – 50); and

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- generating hedging instruction (currency conversion) information to provide instructions on whether to exchange from said first type of currency to said second type of currency (exchange or suspend currency conversion), based on said hedging rules (currency conversion programming). (see col. 6, lines 20 – 36).

Pool does not teach underlined limitations – a method comprising the steps of:

- receiving business transaction information regarding at least one of purchases and sales of goods by a customer.

Currency conversions and hedging currency conversions during actual transactions, in addition to pre-transaction calculations, are old and well known in the art of international and/or cross-border transactions, as evidenced by Mancini (see abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Pool by incorporating the ability to handle actual transactions, as disclosed by Mancini, in addition to pre-transaction calculations, as disclosed by Pool, allowing for application of currency conversion and hedging rules throughout the entirety of the transaction process.

Regarding Claim 2, Pool discloses a method wherein:

- said transaction information (product selection) is received via at least one data transmission, wherein said public price information (currency conversion) is generated as at least one price data stream, and wherein said hedging instruction information (displayed price or suspension

message) is generated as at least one hedging instruction data transmission. (see col. 5, lines 10 – 23 and col. 5, line 58 – col. 6, line 3).

Pool does not teach the underlined limitations – a method wherein:

- said transaction information is received via at least one transaction data stream, wherein said public price information is generated as at least one price data stream, and wherein said hedging instruction information is generated as at least one hedging instruction data stream. (see col. 5, lines 10 – 23 and col. 5, line 58 – col. 6, line 3).

However, Mancini discloses that the currency conversion and hedging functions (“continued risk assessment”) could occur in real-time. (see col. 1, lines 53 – 61).

Furthermore, Mancini discloses that data transmissions could occur in real-time (“notification can be real-time”) utilizing current information (see col. 6, lines 17 – 19 and col. 9, lines 12 - 27). Thus, it would have been within the level of ordinary skill in the art to receive and generate information as a data stream, allowing for continuous receipt and generation of information from this real-time process through a data stream, allowing for continual flow of information to and from said system to allow for such real-time risk assessment.

Regarding Claims 3 – 5, Pool discloses a method further comprising:

- the step of receiving market rate information (“currency information”) having current market foreign exchange rates (“conversion data”), including rates for exchanging said first type of currency (“currency of the country in which catalogue originates”) to said second type of currency

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("[currency] selected by the customer"), and vice-versa. (see col. 4, lines 1 – 20 and col. 6, lines 4 – 19);

- wherein said step of generating said public price information ("price is displayed") is further based on the received market rate information ("currency information"). (see col. 5, line 58 – col. 6, line 3); and
- wherein said market rate information ("currency information") is received via at least one market rate data transmission. (see col. 4, lines 1 – 20).

Pool does not teach underlined limitations - a method further comprising:

- wherein said market rate information is received via at least one market rate data stream.

Mancini does not explicitly teach that the step of receiving nor generating information as a data stream. However, Mancini discloses that the currency conversion and hedging functions ("continued risk assessment") could occur in real-time. (see col. 1, lines 53 – 61). Furthermore, Mancini discloses that data transmissions could occur in real-time ("notification can be real-time") utilizing current information (see col. 6, lines 17 – 19 and col. 9, lines 12 - 27). Thus, it would have been within the level of ordinary skill in the art to receive and generate information as a data stream, allowing for continuous receipt and generation of information from this real-time process through a data stream, allowing for continual flow of information to and from said system to allow for such real-time risk assessment.

Regarding Claims 6 - 7, Pool discloses a method wherein:

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- wherein said pricing rules further define said foreign currency prices of said goods based on either the actual current market rate or said actual current market rate ("conversion rate") adjusted by a predetermined amount ("small percentage"). (see col. 6, lines 4 – 19).

Pool does not teach underlined limitations – a method wherein:

- said pricing rules further define when to update said foreign currency prices of said goods, based on at least one of when the current market rate fluctuates by at least a first predetermined amount, when the rate from the public price information deviates from the current market rate by at least a second predetermined amount, and after the expiration of a predetermined time interval; and
- wherein said pricing rules further define rules to update said foreign currency prices of said goods, based on either the actual current market rate or said actual current market rate adjusted by a predetermined amount.

Mancini discloses a method wherein:

- said pricing rules further define said foreign currency prices of said goods, based on at least one of when the current market rate ("spot rate") fluctuates by at least a first predetermined amount ("more than x% over the fixed time period") and after the expiration of a predetermined time interval ("reset period"). (see col. 9, lines 62 – 67 and col. 10, lines 49 – 63).

Updating electronically displayed information, such as a displayed price, is old and well known in the art of e-commerce. Examples of such updating of electronically displayed information, such as prices, are abundant among online businesses such as e-Bay and e-Trade, allowing for real-time monitoring of prices. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Pool and Mancini by incorporating an automated updating of prices, as is old and well known in the art, when the underlying conversion rate changed, such as when the market rate fluctuated by a predetermined amount or expiration of a predetermined time interval, as disclosed by Mancini, providing users with accurate and up-to-date foreign currency prices of said goods.

Regarding Claims 8 – 9, Pool discloses a method wherein:

- said hedging rules further define when to exchange said first and second types of currency (currency conversion “suspension can be automatic”).
(see col. 6, lines 19 – 50).

Pool does not teach underlined limitations – a method wherein:

- said hedging rules further define when to exchange said first and second types of currency, based on at least one of when the current market rate deviates from the market information by at least a predetermined percent, after the expiration of a predetermined time interval, after a predetermined amount of units of said goods are sold or purchase, and after a predetermined amount of currency received from sales or due from purchases of said goods; and

- wherein said hedging rules further define an amount to exchange said first and second types of currency, based on either a total accumulated revenue or deficit of said first type of currency or a predetermined percent of said total.

Mancini discloses a method wherein:

- said hedging rules further define when to exchange said first and second types of currency, based on at least one of after the expiration of a predetermined time interval (“time period for which a fixed exchange rate has been set”), after a predetermined amount of units of said goods are sold or purchase (“a certain number of transactions take place”), and after a predetermined amount of currency received from sales or due from purchases of said good (“certain local currency notional amount is reached”). (see col. 12, lines 37 – 44); and
- wherein said hedging rules further define an amount to exchange said first and second types of currency, based on either a total accumulated revenue (“aggregated sales”). (see col. 1, line 62 – col. 2, line 11).

It would have been obvious to one of ordinary skill at the time the invention was made to have modified Pool and Mancini by incorporating various qualifiers and contingencies to the hedging rules, as disclosed by Mancini, allowing for continued risk assessment, as disclosed by Mancini, on the basis of such scenarios. (see col. 1, lines 53 – 61).

Regarding Claims 10 – 12, Pool discloses a method wherein:

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- said steps of generating said public price information and generating said hedging instruction information are performed in a computerized system (“a plurality of computer databases and systems”). (see col. 3, line 60 – col. 4, line 31);
- said computerized system is configured within at least one of a local network (“World Wide Network or private networks”) and a stand-alone computer (customer computer through which customer accesses “internet website or private site controlled by the international transaction program”) (see col. 3, line 1 – 10 and col. 3, line 37 – col. 4, line 31); and
- said computerized system (“computer databases and systems”) is configured within an application service provider, remote from said customer (“internet website or private site controlled by the international transaction program”) (see col. 3, line 1 – 10 and col. 3, line 37 – col. 4, line 31).

Regarding Claims 13 – 15, Pool discloses a method further comprising the steps of:

- wherein said market rate data transmission (“currency information, including conversion data”) is received from a database. (see col. 3, line 60 – col. 4, line 20).

Pool does not teach underlined limitations – a method further comprising the steps of:

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- forwarding said at least one hedging instruction data stream to a foreign exchange (FX) rate provider of said customer; and
- exchanging, by said FX rate provider, currency of said first type to currency of said second type based on the received hedging instruction data stream;
- wherein said market rate data stream is received from said FX rate provider of said customer; and
- wherein FX rate provider is at least one of a multi-bank website, an individual bank website, and a non-bank website offering a live market foreign exchange rate stream and an exchange service based on said price stream.

Mancini discloses a method further comprising the steps of:

- forwarding said at least one hedging instruction data stream (“transmission of aggregation data” and “[a] decision to trade”) to a foreign exchange (FX) rate provider of said customer (“currency exchange provider”). (see Fig. 3a and 3b, 317; col. 12, line 64 – col. 13, line 9); and
- exchanging, by said FX rate provider (“currency exchange provider”), currency of said first type to currency of said second type (“exchanging currency”) based on the received hedging instruction data stream (“transmission of data”). (see Fig. 3a, 313 – 315; Fig. 3b, 314, 323 and 325; col. 9, lines 12 – 36; col. 12, line 64 – col. 13, line 9);

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- wherein said market rate ("market price") data transmission is received from said FX rate provider of said customer ("currency exchange system"). (see col. 5, lines 7 – 23); and
- wherein FX rate provider ("currency exchange system") is an exchange service ("currency exchange") based on said price data transmission. (see Fig. 3a and 3b; col. 5, lines 7 – 23).

However, Mancini discloses that the currency conversion and hedging functions ("continued risk assessment") could occur in real-time. (see col. 1, lines 53 – 61). Furthermore, Mancini discloses that data transmissions could occur in real-time ("notification can be real-time") utilizing current information (see col. 6, lines 17 – 19 and col. 9, lines 12 - 27). Thus, it would have been within the level of ordinary skill in the art to receive and generate information as a data stream, allowing for continuous receipt and generation of information from this real-time process through a data stream, allowing for continual flow of information to and from said system to allow for such real-time risk assessment.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Pool and Mancini by incorporating the ability to communicate and exchange information with a FX rate provider, as disclosed by Mancini, as an FX rate provider would have the best capability for quoting currency conversion data and to enact such proposed currency conversion transaction.

Regarding Claims 16 – 18, Pool discloses a method wherein:

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- said transaction data transmission (“electronic purchase orders”) is received from a business-to-business (B2B) portal, said B2B portal is a medium to allow said customer to buy said goods (“electronic catalog stored on a publicly accessible database”). (see col. 1, lines 30 – 50); and
- said B2B portal is at least one of an online marketplace (“electronic merchandise catalogue and ordering systems for use on the internet/intranet). (see col. 1, lines 8 – 11); and
- further comprising the step of forwarding the public price data transmission (currency converted price) as an electronic ticket (electronic “commercial invoice”) to at least one of said customer. (see col. 12, lines 33 – 45).

Pool does not teach underlined limitations – a method wherein:

- said transaction data stream is received from a business-to-business (B2B) portal, said B2B portal is a medium to allow said customer to buy and sell said goods; and
- further comprising the step of forwarding the hedge instruction data streams and the public price data streams as an electronic ticket to at least one of said customer.

Mancini discloses a method wherein:

- said transaction data transmission is received from a business-to-business (B2B) portal, said B2B portal is a medium to allow said customer to buy

("e-Buyer Site") and sell ("e-Seller Site") said goods. (see Fig. 3a, 312; Fig. 3a, 322.

However, Mancini discloses that the currency conversion and hedging functions ("continued risk assessment") could occur in real-time. (see col. 1, lines 53 – 61). Furthermore, Mancini discloses that data transmissions could occur in real-time ("notification can be real-time") utilizing current information (see col. 6, lines 17 – 19 and col. 9, lines 12 - 27). Thus, it would have been within the level of ordinary skill in the art to receive and generate information as a data stream, allowing for continuous receipt and generation of information from this real-time process through a data stream, allowing for continual flow of information to and from said system to allow for such real-time risk assessment.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Pool and Mancini by incorporating the ability to receive transaction data from a B2B portal to allow said customer to buy and sell goods, as disclosed by Mancini, as both transactions are just two opposing sides to the same underlying transaction.

Recording transaction details and forwarding transaction details to parties involved in said transaction is old and well known in the art of conducting business transactions and record keeping. Examples of such recording and forwarding of transaction details would be when a stockbroker sends a confirmation to a client following a securities transaction. Ideally, the confirmation would indicate the client's instructions to the stockbroker and the actual consequences of those instructions.

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Additionally, vendors traditionally produce detailed receipts or itemized invoices to their clients listing the actions taken, items purchased and involved prices for therein.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Pool and Mancini by incorporating the ability to generate and forward transaction information to parties involved in said transaction, as is old and well known, in the form of an electronic ticket, as disclosed by Pool, allowing parties to maintain appropriate business records and monitor transaction accuracy.

Regarding Claim 19, Claim 19 recites similar limitations to Claim 1 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 1.

Claim 19 deviates from Claim 1 in that Claim 19 states prices “based on at least on of a predetermined foreign exchange rate.” However, Mancini discloses that the foreign exchange rate utilized for price conversion could be based on “a predetermined currency price which has been programmed for a predetermined time.” (see col. 5, lines 7 – 23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Pool and Mancini by incorporating the possibility that the foreign exchange rate was predetermined, as disclosed by Mancini, allowing for the possibility that a user might be able to negotiate a foreign exchange rate, as disclosed by Mancini. (see col. 1, lines 43 – 49).

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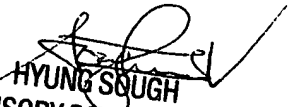
Regarding Claims 20 – 37, further apparatus claims would have been obvious from method claims rejected above, Claims 1 – 19, and are therefore rejected using the same art and rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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